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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,762	12/27/1999	CARL H. HAUSER	D/99477	9175

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PATENT DOCUMENTATION
XEROX CORPORATION
100 CLINTON AVE. S., XEROX SQ. 20TH FLOOR
ROCHESTER, NY 14644

EXAMINER

LIN, KENNY S

ART UNIT PAPER NUMBER

2154

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,762

Applicant(s)

HAUSER, CARL H.

Examiner

Kenny Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Unger et al (hereinafter Unger), US Patent 5,721,910.

4. Unger was cited on the previous office action.

5. As per claims 1, 3 and 5, Unger taught the invention substantially as claimed including a computer-implemented method/computer program product having a computer-readable medium holding computer-executable instructions for performing a method for managing a plurality of personal documents (col.2, lines 58-63, col.13, lines 2-15), comprising

- a. loading one of the plurality of personal documents into storage, said loaded document having a category (col.2, lines 58-65);
- b. determining the document category (col.3, lines 9-15);

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- c. extracting information from said loaded document (col.1, lines 21-24, col.7, lines 26-46, col.10, lines 34-37);
- d. receiving at least one processing rule, wherein the rule is associated with the document category (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46), and wherein said processing rule embodies information-flow-knowledge between said loaded document and other of said plurality of personal documents (col.4, lines 44-57, col.5, lines 17-35, col.7, lines 40-46, col.8, lines 65-67, col.9, lines 1-4, 54-60); and
- e. processing said loaded document according to the processing rule (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46) and said extracted information to related said loaded document with one or more of said other of said plurality of personal documents (col.7, lines 26-51, col.10, lines 34-65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter Unger), US Patent 5,721,910.

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8. As per claim 7, Unger taught the invention substantially as claimed including a method comprising:

- a. Accessing, on the one or more first computers, computer-executable instructions, which when executed by a computer (col.2, lines 58-63, col.13, lines 2-15), perform the steps of:
 - i. loading one of a plurality of personal documents into storage, said loaded document having a category (col.2, lines 58-65);
 - ii. determining the document category (col.3, lines 9-15);
 - iii. extracting information from said loaded document (col.1, lines 21-24, col.7, lines 26-46, col.10, lines 34-37);
 - iv. receiving at least one processing rule, wherein the rule is associated with the document category (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46), and wherein said processing rule embodies information-flow-knowledge between said loaded document and other of said plurality of personal documents (col.4, lines 44-57, col.5, lines 17-35, col.7, lines 40-46, col.8, lines 65-67, col.9, lines 1-4, 54-60); and
 - v. processing said loaded document according to the processing rule (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46) and said extracted information to related said loaded document with one or more of said other of said plurality of personal documents (col.7, lines 26-51, col.10, lines 34-65).

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9. Unger did not specifically teach the system to transfer the computer-executable instructions from the one or more first computers to the second computer connected to the one or more first computer through a communications medium. However, Unger taught that the method can be implemented in a computer system (col.4, lines 33-43) and that the documents may be on a CD-ROM, in a database, a LAN/WAN or on the Internet (col.1, lines 49-54, col.6, lines 51-55). Furthermore, Unger taught to search for documents and electronically store the results in tables (col.5, lines 56-66) wherein the documents may be stored remotely over the Internet (col.1, lines 49-54, col.6, lines 51-55). Official Notice is taken that both the concept and advantage of transferring computer-executable instruction from one computer to another is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to transfer data files or executable instruction from one computer to another through a medium in a computer system especially in obtaining/requesting data files in LAN/WAN or Internet networks from remote databases. One would have been motivated to send a requesting/searching instruction to a remote computer containing databases to obtain the desired documents from the database. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to transfer the computer-executable instruction contained in Unger's system from one computer to another through a communication medium for sharing purposes.

10. Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter Unger), U.S. Patent 5,721,910, in view of MacPhail, U.S. Patent 5,107,419.

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11. MacPhail was cited on the previous office action.

12. As per claims 2, 4, 6 and 8, Unger taught the invention substantially as claimed in claims 1, 3, 5 and 7. Unger did not specifically teach the processing rule to include retention criteria for determining how long to save the document. MacPhail taught a document classification system to have the processing rule to include retention criteria for determining how long to save the document (col.1, lines 59-63, col.3, lines 6-9, 19-21, 26-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Unger and MacPhail because MacPhail's teaching of using retention criteria to determine whether the documents stored in the document storage exceeds expiration date can help the processing rule in Unger's system to automatically delete the to documents that are no longer needed to save system storing space (col.1, lines 59-63).

Response to Arguments

13. Applicant's arguments filed 7/19/2004 have been fully considered but they are not persuasive.

14. In the remark, applicant argued that (1), Unger's document are not personal documents, but are technical documents. Personal documents are bills, checks, receipts...etc. according to page 5, lines 3-6 of the specification. (2), Unger reference teaches nothing about a processing rule associated with a document category where the rule embodies information-flow-knowledge between one document and another.

15. The examiner traverse the argument that:

As to point (1), technical documents are considered personal documents since technical documents such as patent application may be personal to the inventors. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., examples of personal documents are bills, checks, receipts) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to point (2), Unger reference taught to receive at least one processing rule (expert technical searches, col.3, lines 9-28), wherein the rule is associated with the document category (categorization, col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46), and wherein said processing rule embodies information-flow-knowledge between said loaded document and other of said plurality of personal documents (patent family relationship and linking of parent patents, col.4, lines 44-57, col.5, lines 17-35, col.7, lines 40-46, col.8, lines 65-67, col.9, lines 1-4, 54-60). Linking the document to its relevant documents such as parent patents inherently requires document flow information in order to coordinate the linking of the documents. Hence, Unger reference inherently teaches the embodiment of information-flow-knowledge.

Conclusion

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16. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703) 305-0438 and will be (571) 272-3968 after October 18, 2004. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
October 7, 2004


10/7/04